

REMARKS

I. Introduction

Claims 15-23 and 26 are currently pending in the present application.

II. Rejection of Claims 15, 16 and 26 under 35 U.S.C. § 102(b)

Claims 15, 16 and 26 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,060,776 ("Spitz"). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

In order to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic.

In support of the rejection, the Examiner contends that the claimed feature of "a clearance space . . . provided outside the sleeve between the exterior of the sleeve and an outer region of an upper area of the base" (as recited in claim 15) is taught by the trench region 10 shown in Fig. 1 of Spitz. However, the trench region 10 of Spitz is clearly inside the sleeve 12. The Examiner appears to be implicitly arguing that either side of the sleeve wall 12 can be considered to be "exterior of the sleeve," but this interpretation is inherently incorrect because the sleeve 12 is a part of an enclosed structure (diode 100), and "interior" and "exterior" of the sleeve are inherently defined by the enclosure.

For at least the foregoing reasons, claim 15 and its dependent claims 16 and 26 are not anticipated by Spitz.

III. Rejection of Claims 17-23 under 35 U.S.C. §103(a)

Claims 17-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Spitz.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claims 17-23 ultimately depend on claim 15. As discussed above, Spitz does not teach or suggest the claimed feature of “a **clearance space** . . . provided outside the sleeve between the exterior of the sleeve and an outer region of an upper area of the base,” as recited in parent claim 15. For at least this reason, claim 15 and its dependent claims 17-23 are not rendered obvious by Spitz.

CONCLUSION

In view of the above, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections be withdrawn. A prompt and favorable action on the merits is respectfully requested.

Respectfully Submitted,

 (R. NO. 36,197)

Dated: November 23, 2011

By: Jong Lee for Gerard Messina
Gerard A. Messina (Reg. No. 35,952)
KENYON & KENYON LLP
One Broadway
New York, NY 10004
(212) 425-7200